

## **REMARKS**

### **I. Introduction**

Claims 1-14 and 16-23 are pending in the application. The indication of allowable subject matter in claims 7 and 8 is acknowledged and appreciated. Nevertheless, reconsideration of the application in view of the following remarks is respectfully requested.

### **II. Arguments**

Reconsideration of the Application is respectfully requested for at least the following two reasons: (1) the Office Action fails to establish a *prima facie* case of obviousness; and (2) the finality of the rejection is improper.

First, the Office Action fails to establish a *prima facie* case of obviousness. In numbered section 2 beginning at page 2 of the Office Action, claims 1-6, 9-14, and 16-23 are rejected as being unpatentable over U.S. Patent No. 4,220,579 to Rinehart ("Rinehart") in view of U.S. Patent No. 6,881,493 to Haveaux et al ("Haveaux" – mistakenly cited as U.S. Pat. No. 4220579 in the rejection). The rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Furthermore, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *See* M.P.E.P. § 2143.01 (VI) (citing *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959)). Here, there is no suggestion or motivation to modify or combine the references because the proposed modification or combination changes Rinehart's principle of operation. Moreover, even if the combination was proper, it does not include all of the limitations required by at least claims 1 and 2.

Claim 1, for example, recites:

A thermoplastic elastomer composition comprising:  
an isotactic polypropylene and EPDM blend, the EPDM  
being cross-linked; and  
syndiotactic polypropylene present in an amount sufficient to

function as a viscosity promoter.

In contrast, Rinehart discloses a thermoplastic elastomeric blend of three primary ingredients A, B, and C, where A is a monoolefin copolymer rubber (e.g., EPDM – *see* column 2, lines 50-68), ***B is an amorphous polypropylene resin*** (e.g., ethylene – *see* column 3, lines 60-65), and C is a crystalline polyolefin resin (e.g., highly crystalline isotactic and syndiotactic forms – *see* column 3, lines 21-51). Ingredients A, B, and C, of Rinehart are present in the following proportions: A (15-80%), B (5-45%), and C (15-80%). Rinehart, column 1, lines 61-64. As noted at lines 11-12 on page 5 of the Office Action, Rinehart differs from the invention recited in at least claims 1 and 2 in that Rinehart teaches utilizing ***an amorphous polyolefin*** as opposed to a ***syndiotactic polyolefin*** to modify the viscosity of the resin blends.

Haveaux is cited on pages 6-7 of the Office Action as teaching that “syndiotactic polypropylene possesses a higher viscosity than the amorphous polypropylene of Rinehart and is known to be useful as a viscosity promoter when used in amounts of from 1-10% of the material” (page 7, lines 12-15). The Office Action further states that “it would have been obvious to one of ordinary skill in the art at the time of applicant’s invention to utilize 1-50 weight% of the syndiotactic polypropylene of Haveaux et al in lieu of the amorphous polypropylene of Rinehart to modify the viscosity of the resin blends of Rinehart” (page 7, lines 15-19). The Applicant respectfully disagrees and submits that the combination is improper.

Importantly, the teachings of Rinehart and Haveaux appear to contradict one another such that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Rinehart or to combine the reference teachings. Rinehart specifically states that ***low viscosity*** is one characterizing property of conventional ***amorphous polypropylene*** (column 4, lines 19-20), and that such low viscosity is a preferred property of the blend disclosed therein in order to improve flow characteristics and make fabrication of injection-molded objects faster and easier (column 6, lines 25-35). Haveaux, on the other hand, teaches that ***syndiotactic/atactic block polypropylene*** is known to be useful as a ***viscosity improver***, especially in motor oil. Haveaux, column 5, lines 39-41. In view of the foregoing, the proposed modification of Rinehart, according to the teachings of Haveaux, would change the principle of operation of Rinehart, i.e., the use of amorphous polypropylene for purposes of low viscosity characteristics. Moreover, the Applicant respectfully points out that the portion of Haveaux’s disclosure cited with regard to the viscosity promoting properties of syndiotactic/atactic

block polypropylene is directed to applications in motor oil and not in the context of thermoplastic elastomer compositions as recited in at least claims 1 and 2 of the instant invention. Thus, the Applicant respectfully submits that the combination of Rinehart and Haveaux is improper and does not render obvious at least claims 1 and 2.

Furthermore, even if the combination were proper, it fails to teach or suggest all the recited limitations in at least claims 1 and 2. Specifically, claims 1 and 2 both recite that the thermoplastic elastomer composition includes “syndiotactic polypropylene in an amount sufficient to function as a viscosity promoter.” Haveaux is cited in the Office Action for its teachings in this regard. Contrary to the assertions set forth in the Office Action, however, Haveaux is directed to the use of the particular properties of syndiotactic/atactic block polypropylene, not syndiotactic polypropylene, as recited in at least claims 1 and 2 of the present Application. Syndiotactic/atactic block polypropylene is not the same as syndiotactic polypropylene (*see, e.g.*, Compendium of Macromolecular Nomenclature, 1st edition, Metanowski, W.V., Blackwell Science, pp. 29 & 34, 1991 [ISBN 0-63202-8475], available at <http://www.iupac.org/publications/books/pbook/PurpleBook-C2.pdf>). The purported combination, therefore, does not teach or suggest a thermoplastic elastomer composition having syndiotactic polypropylene present in an amount sufficient to function as a viscosity promoter.

Accordingly, the Applicant respectfully submits that at least claims 1 and 2 are allowable. Claims 3-14 and 16-23 depend from one of claims 1 and 2, and are, therefore, submitted as being allowable for at least the same reasons.

Second, with regard to the finality of the rejection, page 8 of the Office Action states that “Applicant has amended the claims to further define the syndiotactic polypropylene component,” and further states that “Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office Action.” The Applicant respectfully disagrees and submits that the amendments made to at least claims 1 and 2 were formal in nature (i.e., for grammatical purposes) and not for reasons related to patentability over the cited prior art references. That is, the Amendment was made in response to the indefiniteness rejection set forth under 35 U.S.C. § 112, second paragraph, and are not believed to effect the scope of the claims so as to necessitate the new grounds of rejection under newly discovered prior art references. Accordingly, reconsideration of the finality of the rejection is respectfully requested.

### III. Conclusion

For the foregoing reasons, it is submitted that all of the claims are allowable over the prior art and that the application is in condition for allowance. An early notice to that effect is respectfully requested. It is not believed that extensions of time or other fees are required beyond those that may otherwise be provided for in documents accompanying this paper. If, however, additional extensions of time are needed to prevent abandonment of this application, such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims or any other fee deficiency), are hereby authorized to be charged, and any overpayments credited to, our Deposit Account No. 22-0261.

The Examiner is respectfully requested to contact Applicant's undersigned Representative if necessary to place the application in condition for allowance. Prompt reconsideration is respectfully requested.

Respectfully submitted,

Date:

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